

REMARKS/ARGUMENTS

Entry of the foregoing amendments, and reconsideration of the subject application in view of the following remarks is respectfully requested.

Applicants respectfully request that the Examiner withdraw the finality of the Office Action in consideration of the Examiner's new grounds for rejection of claim 17 under 35 U.S.C. § 112, first paragraph based upon the organopolysiloxane formula. Under MPEP § 706.07(a), a second or subsequent action cannot be final where the Examiner introduces a new grounds for rejection that was not necessitated by Applicants' amendment of the claims. Applicants' previous claim amendments filed on November 4, 2003 did not in any way alter the organopolysiloxane formula of claim 17. Therefore, this new grounds for rejection could not have been necessitated by Applicants' amendment of the claims in the previous response, and thus a final rejection is improper.

Claims 1-17, 19-24 and 33 remain pending in this application. Applicants propose amending claims 1, 3 and 17. Applicants respectfully submit that the amendments to these claims places them in condition for allowance and in a better form for consideration on appeal. No new matter is added by the amendments.

As the present response addresses all outstanding issues, Applicants once again respectfully request that the Examiner declare an Interference consistent with their Second Request for an Interference pursuant to 37 C.F.R. § 1.607 filed on November 4, 2003.

I. Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 17 and 19-24 remain rejected under 35 U.S.C. § 112, first paragraph as allegedly containing new matter. In particular, the Patent Office alleges that Applicants identification of support for the instant claims does not provide full support for “(i) the formula of the organopolysiloxane and (ii) the range of peroxide, respectively, of claim 17.” Office Action, page 2. Each of these issues is discusses separately below.

A. The claimed peroxide range is expressly disclosed

With regard to the range of the peroxide, the Examiner asserts that “Applicants’ Examples 1 and 2 can only support two data points at most.” Office Action, page 2. However, contrary to the Examiner’s assertion, the claimed peroxide range finds express support in the instant specification. In particular, Applicants respectfully direct the Examiner’s attention to page 3, lines 12-13 of the instant application which states the claimed peroxide range of “from about 0.1% to about 5% by weight of the total composition of a curing agent.” The application further provides that “the curing agent is a peroxide based curing agent . . .” See page 4, lines 20-22.

The use of the expression “weight parts” for the claimed peroxide range is entirely consistent with the disclosure in the specification of “weight percent” for the range, as would be understood by a person skilled in the art. This is further illustrated by the Examples. For instance, Example 1 of the specification describes the preparation of the claimed product using “1.25 parts 2,5-dimethyl(t-butylperoxy)hexane peroxide,” which is well within the claimed range. See page 12, lines 22-23. Likewise, Example 2 of the specification describes the preparation of

the claimed product using “1.4 parts 2,4-dichlorobenzoyl peroxide,” which is also well within the claimed range. See page 15, lines 2-3.

It is well established that “[t]he fundamental factual inquiry [for determining compliance with the written description requirement] is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” See MPEP § 2163.I.B. (Eighth Ed. Rev. 2 2004) (citing *Vas-Cath, Inc.*, 935 F.2d 1555, 1563-64, 19 USPQ2d at 1117 (Fed. Cir. 1991)). Here, the claimed peroxide ranges are expressly disclosed in the original specification. Thus, it is apparent that the specification conveys that Applicants were in possession of the peroxide ranges recited in claim 17.

B. The formula of organopolysiloxane is implicitly and inherently disclosed

The Examiner asserts that “Applicants have not yet identified the support for the formula organopolysiloxane [of claim 17].” See Office Action, page 2. [As noted above, Applicants believe that this is a new rejection, not raised in the first Office Action or necessitated by amendment thereafter, and thus request that the Examiner withdraw the finality of this Office Action.] Applicants respectfully submit that the organopolysiloxane formula recited in claim 17, namely $R_aSiO_{(4-a)/2}$ in which R is selected from substituted and unsubstituted monovalent hydrocarbon groups and a has a value from 1.95 to 2.05, is implicitly and inherently disclosed in the original specification. Applicants specifically identify the support for this formula below.

It is well established that the subject matter of a claim need not be described literally for the disclosure to satisfy the description requirement. See MPEP § 2163.I.B. Newly added claim limitations may be supported in the specification

through express, implicit or inherent disclosure. *See Id.* For example, “[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species.” *See* MPEP § 2163.05.I.

Here, the formula of claim 17 is well supported in the original specification by sufficient description of a representative number of species. For instance, Example 1 of the specification discloses a diorganopolysiloxane gum “consisting of 99.77 mole % dimethylsiloxane units and 0.23% methylvinylsiloxane units.” Page 12, lines 9-11. Further, Example 1 of the present specification also provides a diorganopolysiloxane gum “consisting of 99.02 mole % dimethylsiloxane units and 0.08 mole % methylvinylsiloxane units.” Page 12, lines 11-13. These example, particularly when viewed in the context of formula I and the substituent groups disclosed in the application, are sufficiently representative to inform a person skilled in the art that Applicants were in possession of the formula recited in claim 17.

In fact, as further evidence that these disclosures sufficiently support the formula of claim 17, Applicants direct the Examiner’s attention to the Matsushita et al. reference cited in the Office Action (U.S. Patent No. 5,824,729). In particular, the reference provides the same formula and states with reference to the formula that “[t]he units constituting this component are specifically exemplified by *dimethylsiloxo*, *methylphenylsiloxo*, *methylvinylsiloxo*, and methyl(3,3,3-trifluoropropyl)siloxo units. See col. 2, ln. 20-23. [emphasis added]

In view of at least the foregoing, Applicants respectfully request that the Examiner withdraw the rejection as to claims 17 and 19-24 under 35 U.S.C. § 112, first paragraph.

II. Claim Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 3-14, 17 and 19-24 are rejected under 35 U.S.C., second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner notes that in claim 3, formula I is incorrect in that the R groups should be attached to Si not O. Further, in claim 17, component (B) is missing.

The foregoing claim amendments address these formalities. In claim 3, formula I is amended to replace the incorrect formula with the correct formula, as is disclosed in the specification and in claim 1. In claim 17, component B has been added. Accordingly, the foregoing amendments obviate the Examiner's basis for rejection. Therefore, Applicants respectfully request that the Examiner withdraw the rejection.

III. Claim Rejection under 35 U.S.C. § 102(e)

The Patent Office rejects claims 1-6, 8-13, 15-24 and 33 as allegedly anticipated by Matsushita et al. (U.S. Patent No. 5,824,729). As discussed above, Applicants have previously submitted a Request for an Interference Pursuant to 37 C.F.R. § 607 accompanied by an affidavit antedating Matsushita as a reference, in accordance with 37 C.F.R. § 608. The interference request has not yet been considered by the Patent Office. A Second Request for an Interference Pursuant to 37 C.F.R. § 607 was also submitted with Applicants' previous response consistent with the previously presented claim amendments. This interference request has also not yet been considered. Although Applicants urge otherwise, the Examiner currently indicates she will not consider Applicants' Request for an Interference until all other issues relating to patentability of this invention have been resolved. When

Applicant's request is considered, the Rule 608 affidavit will remove Matsushita as a reference.

IV. Claim Rejection under 35 U.S.C. § 103(a)

A. Matsushita et al.

Claims 7, 12, and 14 are rejected as obvious over Matsushita et al. As discussed above, Applicants respectfully traverse the rejection because Matsushita is not a proper reference and should be removed upon the Patent Office's consideration of Applicants' Request for an Interference and Rule 608 affidavit.

B. Dams in view of Milbert

Claims 1-17 and 19-24 and 33 are rejected as obvious over Dams (U.S. Patent No. 4,355,129) in view of Milbert (U.S. Patent No. 3,821,140). Applicants respectfully traverse the rejection for the following reasons.

First, Dams and Milbert are not properly combinable because there is no suggestion or motivation to combine the reference teachings. To establish a *prima facie* case of obviousness, there must be (1) a suggestion or motivation to combine the references, as well as (2) a reasonable expectation of success and (3) a teaching or suggestion in the prior art of all the claim limitations. *See* MPEP § 2143. The Examiner has cited no teaching in the prior art of the desirability of the claimed invention. Indeed, Dams and Milbert are directed to entirely different purposes (Dams to silicone rubber with improved color retention when exposed to corona discharge and Milbert to a fire resistant elastomer). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP

§ 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

Here, the Examiner can point to no suggestion in the prior art that the combination would be in any manner desirable. “Obviousness cannot be predicated on what is not known at the time an invention is made . . .” See MPEP § 2141.02 (citing *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)). Therefore, a *prima facie* case of obviousness is not established.

Secondly, even if the references were properly combinable, a *prima facie* case of obviousness would still not be established because Milbert fails to remedy the deficiencies of Dams. For example, among other things, Dams is deficient in failing to disclose the claimed range of the coupling agent (from about 0.01% to about 1% by weight of the total composition of a coupling agent). Milbert fails to remedy this deficiency because Milbert also fails to teach the claimed range of coupling agent or any species in an amount falling within that claimed range. The Examiner appears to misapprehend the significance of the coupling agent when she states in the Office Action that “[t]he amount of coupling agent can be optimized through routine experimentation and such amount is likely to fall in the range of the instant claims . . .” See Office Action, pages 3-4. Applicants note in this regard that the amount of coupling agent is not an optional component of the present invention.

Further, the present specification states as follows:

[a]n organosilane coupling agent, as used in the compositions of the present invention, act as (a) surface modifier for fumed silica and ATH, and (b) as a cross linker for the coupling between fumed silica and ATH with siloxane polymers. By having a coupling agent, ATH and fumed silica are rendered hydrophobic, and they interact with polysiloxanes thus enhancing their dispersibility and reinforcing effect. These effects are evident from the physical and electrical properties of silicone rubber prepared.

Page 7, lines 21-27. This provides evidence of the criticality of the coupling agent and the required range as recited in the claims. Given the unpredictability of the art and the fact that Milbert teaches outside the claimed range, it seems unreasonable to infer that “such amount is likely to fall in the range of the instant claims.” Also, there is no recognition in the prior art that the coupling agent amount is a result-effective variable. This further mitigates against a finding that the claimed ranges could be obtained through routine experimentation.

Moreover, not only does Milbert fail to remedy the deficiencies of Dams, but Milbert actually teaches away from Dams. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). The only amounts of coupling agent disclosed by Milbert are amounts that exceeds the claimed range. In particular, the amounts disclosed in Milbert’s Example 1 are 4% for Composition A, 2% for Composition B and 2% for Composition C. This disclosure by Milbert clearly teaches away from the claimed range of about 0.01% to about 1% by weight of the total composition. Therefore, a *prima facie* case of obviousness would not be established even if the references were combined, .

Finally, even if a *prima facie* case of obviousness was established, it would be rebutted by the unexpected results achieved by the claimed invention. Evidence of the unexpected results is provided in the present specification. In particular, the specification states that “[a]ll the products prepared showed superior physical properties. The Shore A hardness (measured by ASTM test No. D-2240) of the products were between 60-80 and Tensile Strength were greater than 500 psi.” See page 9, lines 12-14.

In view of at least the foregoing, Applicants submit that claims 1-17, 19-24 and 33 are in condition for allowance and reiterate their request that the Patent Office withdraw its rejection and declare an interference with Matsushita and U.S. Patent No. 6,090,879.

V. Conclusion

Applicants respectfully request that the Examiner withdraw the outstanding rejections and declare an Interference as previously requested. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below to conduct an interview in an effort to expedite prosecution in connection with the present application. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.

Respectfully submitted,

Dated: October 15, 2004 By: Scott Yarnell

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